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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	76649149
Applicant	I.O.B. Realty, Inc.
Applied for Mark	PATSY'S PIZZERIA
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BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Applicant: I.O.B. Realty, Inc.

Appl. No.: 76/649,149

Examining Attorney: Dezmona Mizelle-Howard

Filed: October 25, 2005

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Mark: PATSY'S PIZZERIA

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BRIEF IN SUPPORT OF APPEAL

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I. DESCRIPTION OF THE RECORD

The Applicant, I.O.B. Realty, Inc., filed a complete application on October 25, 2005, to obtain federal registration of the mark PATSY'S PIZZERIA for pizzeria services in International Class 43. In an Office Action of April 28, 2006, the Examining Attorney asserted that the Applicant's Mark could be confusingly similar to five trademark registrations and two pending applications (all owned by the same entity) and raised two informalities: clarifying the recitation of services and a disclaimer of "PIZZERIA." The Applicant provided the necessary clarification to the identification of services and disclaimed "PIZZERIA." The Applicant responded that the Second Circuit, in 2003, decided that the Applicant has the right to use its mark, and was expressly entitled to register the mark despite any perceived confusion with the Registrant's marks.

In a second Office Action of June 24, 2007, the Examining Attorney noted that the two prior pending applications had matured into registrations and included the two new registrations as bases for refusal of the Applicant's Mark. The Applicant responded that it was the owner of Registration No. 2,213,574, which had been erroneously cancelled and that the reinstatement of that registration had been ordered by the Eastern District of New York on summary judgment, but the Commissioner would not restore the registration until the litigation was finally concluded.¹ The Applicant further provided substantive arguments; addressing the dissimilarities of the Applicant's Mark and services with the marks and services in the cited registrations, as well as the long-standing use and fame of the Applicant's Mark.

¹ This summary judgment decision was later vacated, *see* Applicant's August 2, 2012, response to the June 25, 2012, office action, discussed *infra*.

On December 30, 2007, Examining Attorney suspended action on the application due to upcoming registration maintenance documents. On July 29, 2008, the Examining Attorney suspended action on the application due to pending cancellation proceedings involving two of the cited registrations.

On June 25, 2012, the Examining Attorney noted the information provided by the Applicant with respect to the cancellation of two of the cited registrations, requested information on the status of the previously pending litigation and restoration of the Applicant's registration, and maintained the refusal based on the five remaining registrations. The Applicant responded that its prior registration was not ultimately restored, but noted that the Courts had recognized a distinction between pizzeria service and restaurant services. The Applicant further, and in line with the Court's findings, amended its identification of services to "pizzeria services."

On October 17, 2012, the Examining Attorney withdrew the refusal based on six of the registrations (two of which had been canceled), and accepted the Applicant's responses to the informalities from the earlier office action. The Examining Attorney maintained, and made final, the Section 2(d) refusal based on the prior cited Registration No. 3,090,551 for the mark PATSY'S OF NEW YORK.

On April 16, 2013, the Applicant submitted a request for reconsideration of the final refusal, responding that there was no likelihood of confusion due to a difference in sight, sound, and meaning, difference in the services, and the Applicant's use of its mark in a variety of services. The Applicant further noted the applicability of recent Court decisions through the application of the doctrine of stare decisis.

On April 16, 2013, the Applicant submitted a notice of appeal.

On June 24, 2013, the Examining Attorney denied the request for reconsideration.

II. STATEMENT OF THE ISSUES

The Applicant appeals the Examining Attorney's refusal to register the mark PATSY'S PIZZERIA for pizzeria services based on a likelihood of confusion with the registered mark PATSY'S OF NEW YORK for restaurant services. The Examining Attorney declined to apply the principle of stare decisis and the recent federal and appellate court decisions regarding the Applicant's and Registrant's cited uses of marks including "PATSY'S," stating that the current proceeding was not sufficiently similar to the court proceedings. The Examining Attorney also stated that the broad wording of the services in cited registration "is presumed to encompass ... [the services] in applicant's more narrow identification," and relied on cited third party registrations. Finally, the Examining Attorney entirely discounted the Applicant's prior use of marks involving "PATSY'S," presumably including the Applicant's prior use of the Applicant's Mark at issue.

The Applicant appeals this final refusal of registration as follows. The appeal fee was previously paid. If any additional fee is due, please charge Deposit Account Number 12-1210.

III. RECITATION OF THE FACTS

The Applicant, I.O.B. Realty, Inc., applied for registration of the mark PATSY'S PIZZERIA for use in connection with pizzeria services in International Class 43 (the "Applicant's Mark"). The Examining Attorney refused registration of the Applicant's Mark on the basis of a likelihood of confusion with the registered mark PATSY'S OF NEW YORK for restaurant services in International Class 42.

The Applicant's response included arguments that the related services of both marks were primarily sold in a visual manner and the visual impression of the marks was sufficiently different to prevent confusion. Additionally, the Applicant noted that, to the extent the asserted

“similarity” of the marks was based on the use of “PATSY’S,” the federal courts have already addressed the use of marks including this term by the Applicant and the Registrant. Under the doctrine of stare decisis, the question of the Applicant’s rights to the mark PATSY’S PIZZERIA has been determined and should be applied to the instant proceeding. The Applicant’s response also noted consumers would be familiar with the Applicant and its Mark from its use of PATSY’S PIZZERIA on other services.

The Examining Attorney denied the request for reconsideration and continued the final refusal to register the Applicant’s Mark PATSY’S PIZZERIA on June 24, 2013, to which the Applicant now appeals.

IV. ARGUMENT

The Examining Attorney refuses registration of the Applicant’s Mark, PATSY’S PIZZERIA, for pizzeria services, on the basis of a likelihood of confusion with the registered mark PATSY’S OF NEW YORK for restaurant services. The Applicant requests reconsideration and reversal of the Examining Attorney’s refusal.

The Applicant’s Mark should be permitted to proceed to registration because there is no likelihood of confusion, particularly when the doctrine of stare decisis is applied.

In deciding if there is a likelihood of confusion, thirteen various factors should be considered, if applicable. *In re E.I. Du Pont de Nemours & Co.*, 476 F.2d 1357, 1361 (Fed. Cir. 1973). Among these factors are the similarity or dissimilarity of the impressions of the marks, including appearance, sound, and connotation; the similarity or dissimilarity and nature of the services; the conditions under which, and to whom, sales are made; the variety of goods on which a mark is used; the length of time and conditions of concurrent use without actual confusion; and any other established fact probative of the effect of use. *Id.*

Doubts about the likelihood of confusion should then be resolved **against the newcomer, and in favor of the prior user** or registrant. *In re Chatam Int'l Inc.*, 380 F.3d 1340, 1345, 71 U.S.P.Q.2d 1944 (Fed. Cir. 2004); and *W.R. Grace & Co. v. Herbert J. Meyer Industries, Inc.*, 190 U.S.P.Q. 308 (T.T.A.B. 1976). In the instant case the Applicant has been using its mark “PATSY’S PIZZERIA” for pizzeria services since 1933. The Registrant of Registration No. 3,090,551 began its use subsequently in October 2005 for restaurant services. Since Registration No. 3,090,551 is the newcomer, any doubts regarding the likelihood of confusion should be resolved in favor of the Applicant. This principle is particularly relevant in this situation where the owner of the cited Registration was aware of the Applicant’s Mark and its use for pizzeria services when the Registrant applied for the cited registration. *See* Request for Reconsideration, Exhibit 1, Opinion and Order of the Eastern District of New York, p. 45 (“Based on the evidence presented at trial, it is undeniable that Plaintiffs were aware of the six Patsy’s Pizzeria locations that I.O.B. Realty licensed to open in Manhattan between 1996 and 2002.”) and October 13, 2006, Response to Office Action, Exhibit 2, p. 4 (noting another of the Registrant’s application was denied by the PTO “on the grounds of likely confusion with the marks previously registered by [the Applicant] for Patsy’s Pizzeria,” and describing the subsequent timing of Board proceedings. In addition, the Registrant would have been made aware of the Applicant’s Mark through this earlier litigation itself).

A. Dissimilarity of the Marks' Impressions

The Applicant's pizzeria services are sold in a visual or self-service manner. Restaurant services and pizzeria services are typically provided through a physical location, with associated marks displayed at least on signage outside or on menus, which are also sometimes posted outside the restaurant or pizzeria. Even in instances where a restaurant or pizzeria offers takeout service, the menus showing the marks associated with the restaurant are seen first. Presumably, the Registrant's restaurant services are primarily sold in this same visual or self-service manner. Therefore, both the Applicant's and the Registrant's marks are first, and primarily, encountered visually.

For goods typically purchased in a visual or self-service manner, where the purchaser sees the goods being bought, sound is not as important. *See Spanger Candy Co. v. Crystal Pure Candy Co.*, 235 F. Supp. 18, 22, 143 U.S.P.Q. 94, 98 (N.D. Ill. 1964). Phonetic similarities become important when the goods are typically sold in a manner relying on sound, such as over the telephone or by radio. *See Lindy Pen Co., Inc. v. Bic Pen Corp.*, 796 F.2d 254, 256, 230 U.S.P.Q. 791, 793 (9th Cir. 1986). Since the Applicant's and Registrant's services are sold on a self-service basis, the visual impact predominates over any phonetic impact. *See Roux Laboratories, Inc. v. Clairol, Inc.*, 157 U.S.P.Q. 391 (T.T.A.B. 1968).

The visual impression of the Applicant's Mark is distinct from that of the Registrant's mark. The Applicant's Mark PATSY'S PIZZERIA is comprised of two elements. The Registrant's mark PATSY'S OF NEW YORK is comprised of four elements. The only shared element is PATSY'S.

The inclusion of the element PIZZERIA in the Applicant's Mark explains to the public that the services offered by the Applicant are related to pizzerias – a very distinct type of food

service that differs from restaurant services in general. *See infra*. Indeed, in the Applicant's concurrent application for same mark the Examining Attorney cited a definition for "pizzeria" that notes a pizzeria is a specialty. *See* Exhibit 1, Ser. No. 77/086,491, May 15, 2007, Office Action, MSN Encarta definition. In contrast, the Registrant's mark is completely devoid of any suggestion that the Registrant offers pizzeria services. Rather, the Registrant's mark includes OF NEW YORK. This is a geographical indicator that is completely lacking from the Applicant's Mark. Since both marks are encountered visually and not phonetically, this visual difference alone creates a different commercial impression between the Applicant's and the Registrant's respective marks. The source identifying elements of the Registrant's mark, OF NEW YORK, is completely lacking in the Applicant's Mark. Similarly, the source identifying elements of the Applicant's Mark, PIZZERIA, is completely lacking in the Registrant's mark. A consumer encountering the Applicant's Mark would not presume that it was related to the cited Registration since there is no geographical indication in the Applicant's Mark, but there is an entirely different term, PIZZERIA. The differences between the elements and details of the marks lead to distinct visual impressions.

1. Application of Stare Decisis

To the extent the Examining Attorney asserts that the element PATSY'S is the dominant portion of each mark, the issue of whether the Applicant and the Registrant can both use marks including PATSY'S has been resolved by the Eastern District of New York and affirmed by the Second Circuit. "[T]he right to register follows the right to use 'as nearly as possible.'" *In re Multivox Corporation of America*, 1981 TTAB LEXIS 41, *17 (T.T.A.B. Feb. 20, 1981) (citing *In re E.I. du Pont de Nemours & Co.*, 177 U.S.P.Q. 563 (C.C.P.A. 1973)). The Court's holdings should be followed under the principle of stare decisis, which is applicable to ex parte

examinations for trademark applications. *See In re Multivox Corporation* and *In re Bordo Products Company*, 1975 TTAB LEXIS 125 (T.T.A.B. Sept. 25, 1975).

[The d]octrine of stare decisis rests upon principle that law by which men are governed should be fixed, definite and known, and that, when the law is so declared by court of competent jurisdiction authorized to construe it, such declaration, in absence of palpable mistake or error, is itself evidence of the law until changed by competent authority.

In re Multivox, 1981 TTAB LEXIS 41, at *11 (quoting BLACK’S LAW DICTIONARY (Third Edition 1933)). “[The doctrine of stare decisis, [] is based upon adherence to precedents, is necessary to provide uniform guidelines and principles to be followed by lawyers as well as by those in a judicial capacity in the interpretation and application of the law based thereon.” *In re Bordo*, 1975 TTAB LEXIS 125, at *7-8.

Any initial impression that the doctrine has little applicability in proceedings involving trademarks in view of the well-known statement that each case has its own personality and must be decided on its own particular facts . . . must necessarily be tempered by the desire and need to end multiple litigation on the same issues or fact situations not only for the purpose of judicial economy but also to protect a party, who was successful in one protracted and expensive proceeding, from having to relitigate the same issue again and again.

In re Multivox, 1981 TTAB LEXIS 41, at *12-13 (citing *Interstate Brands Corp. v. Celestial Seasonings, Inc.*, 198 U.S.P.Q. 151 (C.C.P.A. 1978)).

a. The Prior Proceeding

The Eastern District of New York determined and the Second Circuit affirmed, after protracted and expensive proceedings, that the Applicant was entitled to use the mark PATSY’S PIZZERIA for pizzeria services and the Registrant was entitled to use the mark PATSY’S ITALIAN RESTAURANT for restaurant services. *See* Request for Reconsideration, Exhibit 1, holding the Applicant “has established the right to use the mark[] . . . PATSY’S PIZZERIA for pizzeria services” (p. 67); and “the parties [must] define their marks distinctly as PATSY’S

ITALIAN RESTAURANT and PATSY’S PIZZERIA; to define the distinct sets of services that they provide; Neopolitan-style fine Italian dining and coal-oven-style pizzeria and related services” (p. 70). *See also* Request for Reconsideration, Exhibit 2, Opinion and Order of the Second Circuit, holding “The original Patsy’s Pizzeria opened in 1933” (p. 6), noting that the jury found the Applicant “was the senior user of the mark[] PATSY’S PIZZERIA and continuously used the mark[] for pizzeria services but not restaurant services” (p. 12); and upholding the distinction between “pizzeria service” and “restaurant services” (pp. 30-31). This holding was based in part on the Applicant’s prior use, and that of its predecessors, of PATSY’S PIZZERIA. (Request for Reconsideration, Exhibit 1, p. 15.) The Eastern District also held that “[s]tarting in the 1990s, [the Applicant] began entering into licensing agreement that allowed other to open establishments bearing the mark PATSY’S PIZZERIA.” (Request for Reconsideration, Exhibit 1, p. 6.)

Moreover, the Eastern District of New York specifically held in its Opinion and Order “that the most effective way for the parties to distinguish their marks is to enjoin both Plaintiffs [including the Registrant] and Defendants from using the mark PATSY’S alone, and without other identifying words, to identify their respective services. Consequently, the Court orders that Plaintiffs [including the Registrant] are required to refer to their restaurant services using the mark PATSY’S ITALIAN RESTAURANT.” (Request for Reconsideration, Exhibit 1, p. 68.) The Eastern District further held that “what must also occur is for the parties to define their marks distinctly as PATSY’S ITALIAN RESTAURANT and PATSY’S PIZZERIA.” *Id.*, p. 70. The Court then held that its “Opinion and Order thus leaves the parties free to seek new concurrent trademark registrations for the marks PATSY’S ITALIAN RESTAURANT and

PATSY'S PIZZERIA pursuant to Section 2(d) of the Lanham Act. ... In that respect, this result rectifies 'the premature and careless manner in which the PTO' dealt with the parties in wrongly issuing registrations to Plaintiffs and then cancelling I.O.B. Realty's registrations in the first instance." *Id.*, p. 71 (citing *Patsy's Italian Rest., Inc. v. Banas*, 508 F. Supp. 2d 194, 210 (E.D.N.Y. 2007.))

The Courts' holding, finding that the Applicant has trademark rights to PATSY'S PIZZERIA despite the use of PATSY'S ITALIAN RESTAURANT by the Registrant, is applicable under the doctrine of stare decisis to this application. The Court's further holdings that the Applicant could seek a registration for PATSY'S PIZZERIA for pizzeria services, notwithstanding the existence of the Registrant, and that the Registrant's should define its marks distinctly as PATSY'S ITALIAN RESTAURANT, must also be considered and support the allowance of this application.

b. The Court's Ruling in the Prior Proceeding is Applicable to the Instant Application

The Applicant's Mark and services are identical in the Court proceedings and in the instant application. Moreover, the services in the cited registration and those in the court proceedings are identical. (*Compare* identification of services in Reg. No. 3,090,551 with Reg. No. 3,009,836, which was initially cited by the Examining Attorney and was one of the exact registrations at issue and was used to identify the services of the Registrant in the court case.) Therefore, the Courts' findings on the Applicant's rights to the mark PATSY'S PIZZERIA clearly fall within the realm of stare decisis and are applicable in this proceeding.

As noted *supra*, the services of the cited registration are identical to the Registrant's services at issue in the prior proceedings. While the Registrant's mark in the Court proceedings

varies slightly from the Registrant's mark cited against the Applicant, the similarities between the Registrant's two marks are not sufficient to prevent the application of stare decisis, particularly if the Examining Attorney views "PATSY'S" as the dominant feature of the marks.

The Registrant's mark in the prior proceeding (PATSY'S ITALIAN RESTAURANT) included only a description of the type of services. Therefore, if the Applicant's addition of PIZZERIA to PATSY'S is not sufficient to distinguish the Applicant's Mark from the cited registration (under the theory that the dominant portion of the marks is PATSY'S), the addition of ITALIAN RESTAURANT to PATSY'S would not be sufficient to distinguish the Registrant's mark in the prior proceedings from the Registrant's mark cited against the Applicant here. More importantly, if the Examining Attorney views PATSY'S as the dominant portion of the Applicant's and Registrant's marks at issue in this application, then the same dominant feature was at issue and decided upon in the prior proceeding.

In the denial of the Applicant's request for reconsideration, the Examining Attorney declined to apply stare decisis, asserting that "[i]n the instant Section 2(d) refusal the marks at issue deal with descriptive/generic wording 'PIZZERIA' and the geographically descriptive wording 'OF NEW YORK,' [and that both parties'] 'services originate or have substantial operation in the state of New York and, thus, the court's decision . . . [does] not adequately address the similarities of such marks.'" However, the origination and substantial operation of the Applicant's and Registrant's services in the state of New York was in fact addressed in the prior proceeding. *See* Request for Reconsideration, Exhibit 1, pp. 5, 6, 63 and 70; and Request for Reconsideration, Exhibit 2, p. 5, ln. 14-15, p. 6, ln. 9-10, p. 7, ln. 5-8, and p. 43, ln. 7-12.

Additionally, the marks in the court proceedings (PATSY'S, PATSY'S PIZZERIA, and PATSY'S ITALIAN RESTAURANT) were *more* similar than the Applicant's Mark and the cited

registrations (PATSY’S PIZZERIA and PATSY’S OF NEW YORK, respectively). As an initial matter, the Applicant’s Mark in the current application is identical to the Applicant’s mark and services considered in the court proceedings, where it was held that the Applicant had rights to the mark PATSY’S PIZZERIA for pizzeria services. The only difference between the cited registration and the Registrant’s marks in the court proceedings is the substitution of “OF NEW YORK” (which the Examining Attorney stated was “geographically descriptive”) in lieu of “ITALIAN RESTAURANT.” As the Examining Attorney has found that “Pizzeria” is descriptive, “Italian Restaurant” would also be descriptive. The substitution of one set of descriptive words for another set of descriptive words does not impact the question of similarity of the marks. More importantly, the Examining Attorney states that “PIZZERIA” and “OF NEW YORK” are both descriptive, causing “PATSY’S” to be the dominant feature of both marks. *See In re Chatam Int’l, Inc.*, 380 F.3d at 1343. The analysis of the similarity of the Applicant’s Mark and the cited registration then reverts back to an analysis of the use of “PATSY’S” – which is precisely the issue that was determined by the courts in the prior proceedings.

Therefore, to the extent that PATSY’S is the dominant feature of the Applicant’s and the Registrant’s marks, the Applicant’s right to use the mark PATSY’S PIZZERIA has already been determined by the Courts, despite the Registrant’s contemporaneous use of marks including the term PATSY’S. Since the Courts have previously decided that the Applicant has the right to use PATSY’S PIZZERIA for pizzeria services despite the Registrant’s marks including PATSY’S for restaurant services, and since “the right to register follows the right to use ‘as nearly as possible,’” the Applicant also has a right to register the instant application for the same mark for pizzeria

services. *In re Multibox*, 1981 TTAB LEXIS 41, at *17 (citing *In re E.I. du Pont de Nemours & Co.*, 177 U.S.P.Q. 563).²

Additional factors that favor applying stare decisis and allowing the Applicant's Mark to proceed to publication include: (1) the services the Applicant now seeks to register with the mark PATSY'S PIZZERIA are identical to the services considered by the Courts; (2) the claimed date of first use for the Registrant's Registration No. 3,090,551 is subsequent to the date established by the Applicant in the prior proceeding; and (3) the prior proceedings were based on findings of fact and law regarding the likelihood of confusion – and not merely a “‘feeling’ that confusion was likely.” *Compare with In re Multivox*, 1981 TTAB LEXIS 41, at *14-15.

Finally, the equitable concerns that persuaded the Board to allow the previously-refused application to issue in *In re Multivox* are applicable here. In *In re Multivox*, the Board noted:

[C]onsidering that applicant would otherwise be precluded from ever seeking to renew its attempt at registration . . . because it cannot seek to cancel the cited registrations because they have been in existence for over five years . . . and because applicant cannot seek an adjudication by way of a declaratory judgment since [the registrant] has not recently made any overtures to applicant or its customers which could justify such a proceeding, **it would be inequitable not to publish** the [applied for] mark

1981 TTAB LEXIS 41, at *19 (emphasis added). Similarly, here, the cited registration has been in existence for five years and the Registrant has not made any overtures to the Applicant or its

² The Examining Attorney's remaining concerns, that other matters (which relate primarily to the evidence of use and policing of the marks) “indicate that the facts are not substantially the same in this application and” the prior court proceedings, are not applicable. These other matters are all precisely of the type that the Examining Attorney later states cannot be properly considered in an *ex parte* proceeding. Of course, one of the bedrocks of stare decisis is that it tempers the “the well-known statement that each case has its own personality and must be decided on its own particular facts,” and it permits judicial economy and thus prevents the need for addressing the same questions through repeated expensive and time consuming *inter parte* proceedings, where the presentation of evidence and arguments on these types of matters are usually permitted. *In re Multivox*, 1981 TTAB LEXIS 41, at *12-13.

customer to justify a declaratory judgment. It would be inequitable not to publish the Applicant's Mark.

B. The Dissimilarities of the Services and Channels of Trade

The Applicant's services (pizzeria services) and the Registrant's services (restaurant services) are also dissimilar. The fact that these two services are separate and distinct is implicitly recognized by the Examining Attorney's statement that the "Registrant's restaurant services ... could expand to include pizzeria services directly." To the extent that the Examining Attorney's concern is that the Registrant will expand to pizzeria services, such a fear may easily be put to rest since a principal of the Registrant has testified that the Registrant does not serve pizza and pizza is not a regular menu item. (*See* Exhibit 2, p. 25, line 21 to p. 26, line 9.)

In addition to the Registrant's own admission that pizzeria services are not offered by the Registrant, the important distinction between pizzeria service and restaurant services has been recognized by the federal courts. The Court specifically found in the prior proceeding a distinction between restaurant services and pizzeria services. (Request for Reconsideration, Exhibit 1, pp. 24-25.) The Court's holding distinguishing the services is entitled to stare decisis. *See supra*. Extrinsic evidence may be considered to show that the description has a specific meaning. *See, e.g., In re Thor Tech, Inc.*, 90 U.S.P.Q.2d 1634, 1638 & n.10 (T.T.A.B. 2009), and *In re Trackmobile Inc.*, 15 U.S.P.Q.2d 1152, 1154 (T.T.A.B. 1990).

Moreover, the definition of "pizzeria" specifically notes that a pizzeria is a speciality. *See* Exhibit 1. As a speciality, a pizzeria is not subsumed by an overly broad and generic "restaurant services" identification – such as the one in the cited Registration. This distinction is even recognized by the Registrant, who testified that a pizzeria is not within the same category as a restaurant. (*See* Exhibit 2, p. 117, lines 9-11.)

The multiple differences in the Applicant's services and the Registrant's services further diminish any likelihood of confusion.

C. The Applicant's Mark Is Used on a Variety of Goods

The Applicant has used the mark PATSY'S PIZZERIA in conjunction with pizzeria services since 1933. Further, the Applicant has been using the same mark for franchising services since December 31, 1998. (*See* Request for Reconsideration, Exhibit 1, p. 6.) The prior use of PATSY'S PIZZERIA by the Applicant and its predecessors has been recognized by the Courts.³ (*See* Request for Reconsideration, Exhibit 1, pp. 14-15.) The Applicant's repeated use of the trademark PATSY'S PIZZERIA on pizzeria and franchising services creates a general pattern associating the mark PATSY'S PIZZERIA with the Applicant. *See Motorola, Inc. v. Griffiths Electronics, Inc.*, 317 F.2d 397, 137 U.S.P.Q. 551 (C.C.P.A. 1963).

D. Registrant's Acquiescence to Applicant's Mark

The Registrant claims its first use of the mark PATSY'S OF NEW YORK for restaurant services in commerce was October 2005. The Applicant first used the mark PATSY'S PIZZERIA for franchising services in commerce in 1933. Moreover, the Registrant knew of the Applicant's use of its Mark since prior to October 2005. However, in the seven years since and despite its knowledge of the Applicant and its pizzeria services, the Registrant has never sought to prevent

³ This statement is not an attack on the cited registration as in *In re Calgon Corp.*, 435 F.2d 596, 168 U.S.P.Q. 278 (C.C.P.A. 1971). In *Calgon Corp.*, the applicant asserted that it was the prior user of the mark at issue for the same goods in its denied application, and that due to its prior use the applicant was entitled to a registration. The Applicant's statement is *not* arguing that it is the prior user of its mark in this application for the same services as the cited registration. Indeed, the Applicant's services and the services in the cited registration are different. Rather, the Applicant is stating that, due to its long-standing use of the same mark as in the instant application, the consuming public is familiar with the mark PATSY'S PIZZERIA and would identify the Applicant as the source of services under the mark.

the Applicant's use of its Mark for based on a likelihood of confusion with the Registrant's cited mark. This silence on the part of the Registrant is particularly noteworthy in light of the numerous legal battles, both before the Courts and the Board, by Registrant against the Applicant, or the Applicant's licensees. *See generally*, October 13, 2006, Response to Office Action, Exhibit 2, and Request for Reconsideration Exhibits 1 and 2. The silence of the part of the Registrant, in light of its awareness of the Applicant's Mark, also favors the publication of the Applicant's Mark.

The dissimilarity of the commercial impressions of the Applicant's Mark and the Registrant's mark, dissimilarity of the services, the Applicant's use of its Mark on a variety of services, and the Registrant's Acquiescence all weigh against a likelihood of confusion between the Applicant's Mark and Registration No. 3,090,551.

V. CONCLUSION

The Applicant respectfully requests that the application be allowed and the mark passed to publication.

Respectfully submitted,

September 3, 2013

Date

/Rebecca J. Stempien Coyle /

Paul Grandinetti

Rebecca J. Stempien Coyle

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EXHIBIT 1

To: I.O.B. Realty, Inc. (mail@levygrandinetti.com)

Subject: TRADEMARK APPLICATION NO. 77086491 - PATSY'S PIZZERIA - PAT003US

Sent: 5/15/07 11:18:24 AM

Sent As: ECOM108@USPTO.GOV

Attachments: [Attachment - 1](#)
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UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 77/086491

APPLICANT: I.O.B. Realty, Inc.

77086491

CORRESPONDENT ADDRESS:

PAUL GRANDINETTI
LEVY & GRANDINETTI
SUITE 408, 1725 K STREET, N.W.
WASHINGTON, DC 20006-1419

RETURN ADDRESS:

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

MARK: PATSY'S PIZZERIA

CORRESPONDENT'S REFERENCE/DOCKET NO : PAT003US

Please provide in all correspondence:

CORRESPONDENT EMAIL ADDRESS:

mail@levygrandinetti.com

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

OFFICE ACTION

RESPONSE TIME LIMIT: TO AVOID ABANDONMENT, THE OFFICE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF THE MAILING OR E-MAILING DATE.

MAILING/E-MAILING DATE INFORMATION: If the mailing or e-mailing date of this Office action does not appear above, this information can be obtained by visiting the USPTO website at <http://tarr.uspto.gov/>, inserting the application serial number, and viewing the prosecution history for the mailing date of the most recently issued Office communication.

Serial Number 77/086491

The assigned trademark examining attorney has reviewed the referenced application and has determined the following:

Search Results

A. Section 2(d) - Likelihood of Confusion Refusal

Registration of the proposed mark is refused because of a likelihood of confusion with the marks in U.S. Registration Nos. 3009836, 3009866, 3034733, and 3090551. Trademark Act Section 2(d), 15 U.S.C. §1052(d); TMEP §§1207.01 *et seq.* See the enclosed registrations.

Trademark Act Section 2(d) bars registration where an applied-for mark so resembles a registered mark that it is likely, when applied to the goods and/or services, to cause confusion, mistake or to deceive the potential consumer as to the source of the goods and/or services. TMEP §1207.01. The Court in *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973), listed the principal factors to consider in determining whether there is a likelihood of confusion. Among these factors are the

 pizzeria

noun

Definition:

[Mid-20th century, < Italian < *pizza* "pizza, pie"]

[Print Preview](#)

See pronunciation key

Search for
"pizzeria" in all of
MSN Encarta

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EXHIBIT 2

00001

1

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IN THE UNITED STATES
PATENT AND TRADEMARK OFFICE

3

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

4

-----X

5

I.O.B. REALTY, INC.

6

Petitioner,

7

vs.

Cancellation No. 28,142

8

PATSY'S BRAND, INC.,

9

Registrant.

-----X

11

PATSY'S BRAND, INC.,

12

Petitioner,

13

vs.

Cancellation No. 29,614

14

I.O.B. REALTY, INC.,

15

Registrant.

-----X

17

18

19

EXAMINATION OF SAL SCOGNAMILLO

20

New York, New York

21

Friday, January 12, 2007

22

23

24

Reported by:

ANGELA GRANT, RPR

25

JOB NO. 190707

00002

1

2

January 12, 2007

3

10:07 a.m.

4

5

Examination of SAL SCOGNAMILLO,

6

held at the offices of Ostrolenk, Faber,

7

Gerb & Soffen, 1180 Avenue of the

8

Americas, New York, New York, pursuant

9

to Notice, before Angela Grant, a

10

Registered Professional Reporter and

11

Notary Public of the State of New York.

12

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19

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21

22

23

24

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00003

1

2

A P P E A R A N C E S:

3
4 COOPER & DUNHAM, LLP
5 Attorneys for Patsy's Italian Restaurant
6 1185 Avenue of the Americas
7 New York, New York 10036
8 BY: NORMAN H. ZIVIN, ESQ.
9
10 LEVY & GRANDINETTI
11 Attorneys for I.O.B. Realty, Inc. and
12 Patsy's Inc.
13 1725 K Street, N.W.
14 Washington, DC 20006-1419
15 BY: PAUL GRANDINETTI, ESQ.
16
17 MEYER, SUOZZI, ENGLISH & KLEIN, P.C.
18 Attorneys for Anthony Banas, Allan
19 Zyller, Al & Anthony's, Patsy's Inc. and
20 BSZ Realty Corp.
21 990 Stewart Avenue, Suite 300
22 Garden City, New York 11530
23 BY: KIERAN X. BASTIBLE, ESQ.
24
25
00004

1
2 S A L S C O G N A M I L L O , called as a
3 witness, having been first duly sworn by
4 a Notary Public, was examined and
5 testified as follows:
6 EXAMINATION BY
7 MR. GRANDINETTI:
8 Q. Please state your name.
9 A. Sal Scognamillo.
10 Q. Please state your address.
11 A. 236 West 56th Street, New York, New
12 York 10019.
13 Q. Good morning.
14 A. Good morning.
15 Q. You've already given your name and
16 address, but the address you gave is the
17 business address, correct?
18 A. Yes.
19 Q. And what businesses are at that
20 address?
21 A. Patsy's Italian Restaurant. Patsy's
22 Brand.
23 Q. Any others?
24 A. 236 West 56th Realty Corp.
25 Q. And any others beyond that?

00005
1 Scognamillo
2 A. That's it.
3 Q. What is your position in Patsy's
4 Italian Restaurant?
5 A. Chef. Co-owner.
6 Q. It's a corporation, I assume?
7 A. Yes.

8 Q. You own shares?
9 A. I do.
10 Q. What percentage of the shares, sir?
11 A. I'm not certain. I'm not certain.
12 I know my parents have been
13 transferring shares over to me.
14 Q. Do you have a controlling interest
15 in the corporation?
16 A. You mean sole controlling or?
17 Q. Can you swing the vote one way or
18 the other?
19 A. Oh, a partner there, yeah. I guess
20 the answer is yes. I guess.
21 Q. You have how many other
22 shareholders?
23 A. Just my cousin Frank and my dad. I
24 think that's it.
25 Q. And your dad is Joe Scognamillo,
00006
1 Scognamillo
2 right?
3 A. Yes.
4 Q. And then Patsy's Brand, are your
5 shares in Patsy's Brand the same percentage as
6 they are in Patsy's Italian Restaurant?
7 A. I know I have 33 percent. I don't
8 know if it's the same.
9 Q. Does Patsy's Brand have any other
10 shareholders other than --
11 A. Frank and my father, no.
12 Q. OK, that's fine.
13 Are you familiar with an individual
14 by the name of Sal Scognamillo who now lives
15 down in Florida?
16 A. He's my uncle.
17 Q. And that would make him your
18 father's brother, then?
19 A. Yeah.
20 Q. Have you had any contact with him
21 recently?
22 A. No.
23 Q. Do you know approximately when the
24 last time was that you had any contact with
25 him?
00007
1 Scognamillo
2 A. Probably 20 years.
3 Q. It's been that long?
4 A. Yeah.
5 Q. Has anybody that works for you,
6 whether attorneys or people in the restaurant,
7 had contact with him recently?
8 A. As far as I know, no.
9 Q. Does Sal Scognamillo down in Florida
10 have any ownership or other interest in
11 Patsy's Italian Restaurant or Patsy's Brand?
12 A. No.

1 Scognamillo
2 A. He never told me anything about
3 that.
4 Q. Do you know whether or not anyone at
5 your restaurant, in the 40s, 1940s, had any
6 discussions with anyone at the Patsy's
7 Pizzeria regarding the name "Patsy's"?
8 A. No.
9 Q. You have no knowledge?
10 A. No, I don't.
11 My father said they never spoke.
12 Q. And your father is passed away,
13 right?
14 A. No, my father is still alive.
15 Q. Still alive. That's right, I'm
16 getting confused. He's one of the
17 shareholders.
18 Has your restaurant on 56th Street
19 always had a bar?
20 A. Yes.
21 Q. And, to your knowledge, that
22 restaurant has never served pizza in any
23 manner?
24 A. Other than, you know, if there's
25 someone comes with their grandchildren, little

00026

1 Scognamillo
2 pizza breads. We make focaccia, things like
3 that.
4 Q. But it's sort of a higher-end style
5 of pizza?
6 A. I guess you could call it that.
7 Q. It's not a regular menu item to have
8 just standard pizza?
9 A. No.
10 Q. And your restaurant does not have
11 any coal-fired furnace or anything of that
12 type, does it?
13 A. We do not.
14 Q. Or oven, coal-fired oven I guess
15 they call it.
16 A. We do not.
17 Q. Are you familiar with any fire that
18 ever occurred at the Patsy's Pizzeria up in
19 Harlem?
20 A. I'm not.
21 Q. Are you familiar with any
22 remodeling, major remodeling projects that
23 ever occurred at the Patsy's Pizzeria up in
24 Harlem?
25 A. No.

00027

1 Scognamillo
2 Q. Have you ever been inside the
3 Patsy's Pizzeria in Harlem?
4 A. No, but I saw it from the outside.
5 Q. About how long ago?

24 sort of names of the dishes or particular
25 recipe or something like that that they would

00115

1 Scognamillo

2 be associating with you?

3 A. Well, I mean, if they had the
4 cookbook, probably. From the cookbook they
5 would say, this is Patsy's recipe. I guess.
6 I don't know.

7 Q. Yeah, but the cookbook uses -- and
8 that's Exhibit 8. It uses sort of traditional
9 names of the dishes.

10 A. Yes. Yes, but in a general -- like,
11 you asked me a question. I'm trying to think
12 of how it would possibly be, and I guess
13 that's how it would possibly be.

14 Q. When it comes to the service to the
15 individual customers at the restaurant,
16 naturally you have a major presence, I
17 imagine, on the floor, correct?

18 A. I try to come out whenever I can.

19 Q. Talk to the various customers?

20 A. (Witness nods.)

21 Q. Famous as well as unknown?

22 A. I flock more to people who are
23 unknown, to make them feel special.

24 Q. Do you train your waiter staff in
25 any way to sort of duplicate that?

00116

1 Scognamillo

2 I mean, you're the famous chef and
3 you're the one on TV, but your basic waiters,
4 do you coach them in any way?

5 A. I certainly ask of them to have, you
6 know, a very good manner about themselves,
7 make sure that they provide good service.

8 Q. Based on your experience, then, at
9 the restaurant, is there something special or
10 unique about the service provided to the
11 customers of the restaurant that would be
12 associated with your brand, your mark?

13 A. Well, I think the comment I hear the
14 most that really makes me happy is they feel
15 like they're coming home. They feel like
16 they've been treated in someone's home. And
17 that's what my grandfather was always about,
18 too. They always felt like this was an
19 extension of their own house. So to that
20 degree, that's, that's heart-warming when I
21 hear that.

22 Q. Is that style of providing waiter
23 service unique to your 56th Street restaurant?

24 A. I doubt it. I mean, I hope other
25 places have good service. I've experienced

00117

1 Scognamillo

2 good service at other restaurants. I mean.

3 Q. In your experience in the
4 restaurant, is there any meaning between --
5 for the difference between restaurant services
6 and restaurant services excluding pizza?

7 MR. ZIVIN: Objection.

8 A. No.

9 Q. Based on your experience, is a
10 pizzeria within the category of restaurants?

11 A. I mean, that's not what I think of.
12 When I think of a pizzeria, I think of -- I
13 don't think of it having a wait staff and
14 tables and service.

15 Q. Please describe what you envision a
16 pizzeria as being, then.

17 A. You go up to the counter, you order
18 a couple of slices of pizza, soda. And they
19 have a couple of tables. You sit down and
20 bring it over yourself, I mean.

21 Q. In other words, if you go into a
22 food service facility and it's self-serve, you
23 don't view that as a restaurant?

24 A. Not particularly, no.

25 I mean, if you're asking me
00118

1 Scognamillo
2 specifically what I see as a difference, when
3 you say the words pizzeria and restaurant,
4 that's what I say.

5 Q. And then maybe this helps.
6 Operations such as a Wendy's, something like
7 that, where you go up and you go to a counter
8 and you get your food, not pizza, but get your
9 food and you sit down on your own, do you see
10 that, do you view that as being a restaurant
11 or not a restaurant?

12 A. It's a funny question.

13 I mean, yes and no. I mean, they're
14 serving food, but it's not what we're
15 describing here, is our restaurant where you
16 have a wait staff and a chef and someone who
17 comes out and talks to you and takes care of
18 you and takes your order and sits you down and
19 makes sure your meal is OK.

20 Q. Well, within the meaning of the use
21 of your marks, what is your understanding,
22 then, of restaurant services?

23 I mean, when you say those services
24 in use with your marks, what are you
25 envisioning? What is meant by that?

00119

1 Scognamillo

2 A. I'm not sure I understand what
3 you're saying. I don't understand exactly
4 what you mean right now.

5 Q. The problem, perhaps, is that I
6 don't understand.

7 I was under the impression that a